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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,495	06/07/2000	Akihito Mochizuki	1232-4423US1	9609
27123	7590	05/19/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			BAROT, BHARAT	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/588,495

Applicant(s)

MOCHIZUKI, AKIHITO

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO RCE FILED ON 01/26/2005

1. Claims 8-12 and 15-22 remain for further examination.

Specification (Abstract)

2. The abstract of the disclosure is objected to because the provided abstract does not contain the proper language and format for an abstract of the disclosure.

Appropriate correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objection

4. Claim 22 is objected to because of the following informalities: Claim 22 line 1 "said storage unit" should be --a storage unit--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8-12 and 15-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The independent claims contain subject matter that "a generating unit arranged to generate a Web page including the additional information to be accessed based on the URL and the Web page including the additional Information (image data)" added by the amendment which is not properly described in the application as filed and also not supported by the disclosures of a certified translation of the Japanese priority application JP 9-035129 filed on February 19 1997 and an US Patent Number 6,101,526; therefore, the US Patents to Linden et al and Chang et al are proper prior art/available as prior art against this application.

Other dependent claims, which are not specifically cited above are also rejected because of the deficiencies of their respective parent claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 8-12, 15-17, and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden et al (U.S. Patent No. 6,360,254). Linden's patent meets all the limitations for claims 8-12, 15-17, and 20-22 recited in the claimed invention.

9. As to claim 8, Linden et al disclose a data communication apparatus (figures 1-2; and column 5 line 59 to column 7 line 10) comprising: a first transmission unit (application server), arranged to transmit a URL representing the existence of additional information to a transmission destination (user) (figure 2; and column 7 lines 11-29); a reception unit (Web server/application server), arranged to receive a reply from the transmission destination for the URL transmitted by the first transmission unit (figure 2; and column 7 lines 30-51); a generating unit (Web server), arranged to generate a Web page including the additional information to be accessed based on the URL; and second

transmission unit (Web server), arranged to transmit the Web page including the additional information based on the reply received by the reception unit (figure 2; and column 7 line 52 to column 8 line 4).

10. As to claims 9-10, Linden et al disclose that the second transmission unit transmits the additional information in a manner different from that of the first transmission unit and to a terminal (Web browser) different from a terminal (email application) to which the data was transmitted by the first transmission unit (figure 2; and column 7 lines 11-62).

11. As to claim 11, Linden et al disclose a link to a location of the additional information is set in the URL transmitted by the first transmission unit (figure 2; and column 7 lines 11-29).

12. As to claim 12, Linden et al disclose a processed content based on the reply received by the reception unit is further transmitted to the transmission destination (figure 2; and column 7 lines 52-62).

13. As to claims 15-16, they are also rejected for the same reasons set forth to rejecting claim 8 above, since claim 15 is merely a method of operation and claim 16 is merely a computer readable medium for the apparatus defined in the apparatus claim 8.

Art Unit: 2155

14. As to claim 17, Linden et al teach a data communication method comprising the steps of: recognizing a received email; displaying an image for display on the basis of a content recognized in the recognition step; and instructing a URL of the email recognized in the recognition step, to transmit a Web page including image data in a method other than the email so as to process the image displayed in the display step (figures 2, 3B, 4B, and 5-7; column 6 line 66 to column 8 line 4; column 8 line 54 to column 9 line 18; and column 9 line 53 to column 10 line 41).

15. As to claim 20, it is also rejected for the same reasons set forth to rejecting claim 17 above, since claim 20 is merely a computer readable medium for the method of operation defined in the method claim 17.

16. As to claims 21-22, Linden et al disclose an input unit arranged to input image data, wherein the additional information is the image data input by the input unit; and a storage unit stores the image data in a plurality of forms respective different image quality, wherein the second transmission unit transmits the image data each of the plurality of forms (figures 1-2 and 5-10; and column 5 line 59 to column 6 line 65).

Claim Rejections - 35 USC § 103(a)

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden et al (U.S. Patent No. 6,360,254) in view of Chang et al (U.S. Patent No. 6,134,584).

19. As to claims 18-19, Linden et al do not disclose that in the instruction step it is instructed to print the image and store the image data.

Chang et al explicitly disclose that in the instruction step it is instructed to print the image and store the image data (see abstract; column 4 line 50 to column 5 line 29; column 7 lines 34-65; and column 9 lines 51-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Chang et al in the data communication method of Linden et al because doing so would provide improved control on the data communication method for transmitting and receiving image data.

Additional Reference

20. The examiner as of general interest cites the following reference.
- a. Mayle et al, U.S. Patent No. 6,542,936.

Contact Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (571) 272-3978.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

May 13, 2005


BHARAT BAROT
PRIMARY EXAMINER